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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,350	07/06/2000	Louis H. Sciupac	DTC 99-09	6397

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SCHNECK & SCHNECK  
P.O. BOX 2-E  
SAN JOSE, CA 95109-0005

EXAMINER

LIPMAN, JACOB

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/611,350

Applicant(s)

SCIUPAC, LOUIS H.

Examiner

Jacob Lipman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The examiner has considered the information disclosure statements submitted on 9/25/200, 10/19/2001, and 6/7/2002.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "14" has been used to designate both a computer and a disk in Figure 1.

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "61" has been used to designate both a public key (page 9 line 5) and a step in Figure 4 (page 9 line 36). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 17 (page 5 line 8). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 43 and 167. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the

Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

7. The disclosure is objected to because of the following informality: On page 9 line 13, "b1" should read "by". Appropriate correction is required.

8. The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double-spaced are required.

### ***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 1 lists comprised elements, but it is an incomplete list, the word "and" should precede the last element of the list.

12. Claim 2 recites the limitation "said data processing unit" in line 2. There is insufficient antecedent basis for this limitation in the claim. Throughout the claims

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applicant changes terminology for like parts, thus rendering the claims confusing and indefinite. Please revise the claims to have identical names for every element each time it is mentioned.

13. Regarding claims 5 and 13, the examiner believes that there are typographical errors, and they are being read as such: In claim 5, line 2 "on" is being read "an", and in claim 13, line 3, the final "and" is being read "are".

14. Regarding claim 7, the phrase "a specified format" renders the claim indefinite because it is unclear what the limitations of this format might be. There seems to be no limitation here if read as is.

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-17, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Valerij et al., US Patent number 5,790,662.

With regard to claims 1, 3, 8 and 13, Valerij discloses a secure transactions system including information carriers (column 1 lines 41-44) distributed to users (column 2 lines 50-51), each having data storage medium (column 1 lines 48-50) to store encrypted (column 6 lines 26-31) messages, keys, signatures and digital certificates (column 1 line 50 and column 5 lines 6-15), and a drive (column 3 lines 37-39)

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connected to a computer (column 8 lines 18-25) having communication protocols for all communication which allow encryption of the messages (column 5 lines 52-57).

Valerij discloses the carrier having a processing circuit (column 1 lines 8-9), which carries out cryptographic functions for the system. The circuit exists in the card, as apposed to being in the drive, to authenticate the drive (column 5 lines 57-65). Removing this security check in a secure system, with tamper-resistant drives to save money would be obvious to one of ordinary skill in the art. The examiner takes official notice that tamper-resistant drives are used to add security to a system. It would have been obvious for one of ordinary skill in the art to implement a tamper-resistant drive in the system disclosed by Valerij to add security, and allow for cheaper carriers to be needed.

With regard to claim 2, the examiner takes official notice that network communications are commonly encrypted. It would have been obvious for one of ordinary skill in the art to encrypt network communications in the system disclosed by Valerij to make the system more secure.

With regard to claims 4-7, Valerij discloses the media is optical (column 1 lines 48-49).

With regard to claims 9, 10 and 12, Valerij discloses a PIN is stored in the carrier (column 6 lines 56-58).

With regard to claim 11, Valerij partitions the information into the data storage of the circuit, and the optical markings, each containing the signature (column 1 lines 45-52).

With regards to claims 14-17, Valerij discloses that aspects of the system are modifiable (column 7 lines 22-30).

***Conclusion***

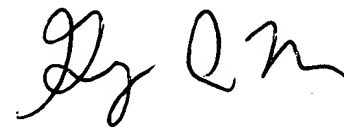
The examiner suggests amending the claims to be less broad, by specifying what the digital certificates, signatures and keys are each used for. The examiner also suggests being less broad as to the lacking of a processor in the "carrier" which can be read as a very small part of a card. For example, a smart card has a processor and memory, but the memory itself can be read as a "carrier" with no processor. These are merely the examiners suggestions, and will not prevent or assure allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 703-305-0716. The examiner can normally be reached on 7:30 - 5 M-Th, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

JL



GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100